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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,812	06/27/2003	Andrew D. Milligan	3670	8393

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EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/607,812	Applicant(s) MILLIGAN ET AL.	
	Examiner Tomasz Ponikiewski	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-36 and 41-43 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u> </u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

1. Claims 1-36 and 41-43 are pending. Claims 37-40 are withdrawn from consideration. Claims 37-40 have been cancelled.

Election/Restrictions

2. Applicant's election without traverse of Group I in the reply filed on 3/13/2006 is acknowledged.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 16 of copending Application No. 10/692549. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications use steps

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that are clearly similar. Claim 1 of the instant application is broader than claim 1 of application 10/692549. For example, claim 1 of instant application states “receiving a request for taxonomy-related information”, claim 1 of application 10/692549 states “receiving a request for taxonomy-related information”. Another step in claim 1 of the instant application recites “querying a database based on the data extracted from the request to obtain taxonomy-related information about at least one node” while the last step of claim 1 of application 10/692549 recites “providing at least one query for taxonomy-related data corresponding to at least one node”. In effect both state the same thing. Another example is claim 17 of instant application states “constructing a request for taxonomy data, the request including identification data from which a taxonomy may be identified and at least one relationship qualifier” while claim 16 of application 10/692/549 states “constructing a request for taxonomy data, the request including data corresponding to an origin node within a taxonomy and data indicating that the request seeks data from one or more nodes”.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

5. Claim 19 is objected to because of the following informalities: the applicant recites “may be” in line 2 which means that in essence it doesn’t have to happen. Therefore has no weight on the invention. Appropriate correction is required.

Claim 28 is objected to because of the following informalities: the applicant recites "may" in line 7 which means that in essence it doesn't have to happen. Therefore has no weight on the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 16, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claims 16 and 27 state the intended use by use of word "for performing". To overcome this type of rejection, claim could be amended to recite definite functionality implemented on a computer (i.e. "executed" or "processed").

9. Claims 16 and 27 recite "computer-readable medium" which is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 10, line 22, the medium is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or

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non-functional media. For this specification, signal-bearing media would be not statutory but storage media would be statutory.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the other taxonomy" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 is vague and indefinite about the scope of the claim. Is the client sending multiple requests at one time or does each request include multiple identifications? The examiner is unclear what the claim adds to the invention claimed.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-36 and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Carson et al. (US PUB 2004/0093326 A1).

As per claim 1 Carson et al. is directed to in a computing environment, a method comprising:

receiving a request for taxonomy-related information, the request including identification data and relationship data (page 4, paragraph 0032, lines 4-5; page 7, paragraph 0072, lines 6-7; page 7, paragraph 0074, lines 2-4);

extracting data from the request (page 7, paragraph 0072, lines 1-3, wherein "extracting" could mean "abstraction");

and querying a database based on the data extracted from the request to obtain taxonomy-related information about at least one node having a relationship that corresponds to the relationship data (page 6, paragraph 0056, lines 8-9).

As per claim 2 Carson et al. is directed to returning the taxonomy-related information in response to the request (page 4, paragraph 0040, lines 7-8).

As per claim 3 Carson et al. is directed to the identification data comprises an identifier of a taxonomy and the relationship data indicates a root node relationship, and wherein returning the taxonomy-related information in response to the request comprises returning an identifier of at least one root node within the taxonomy (page 2, paragraph 0010, lines 6-14).

As per claim 4 Carson et al. is directed to returning the taxonomy-related information in response to the request comprises identifying the relationship along with each other node identifier that corresponds to the relationship data (page 2, paragraph 0010, lines 6-14).

As per claim 5 Carson et al. is directed to the identification data comprises an identifier of a taxonomy and a node identifier of a node within the taxonomy, and wherein returning the taxonomy-related information in response to the request comprises returning at least one other node identifier that corresponds to the relationship data (page 7, paragraph 0073, lines 2-7).

As per claim 6 Carson et al. is directed to the relationship data indicates a parent relationship (figure 2a, wherein retrieval(244) is parent of healthcare(261)).

As per claim 7 Carson et al. is directed to the relationship data indicates a child relationship (figure 2a, wherein healthcare(261) is child of retrieval(244)).

As per claim 8 Carson et al. is directed to returning the taxonomy-related information in response to the request comprises returning an identifier of another taxonomy (page 7, paragraph 0068, lines 10-12).

As per claim 9 Carson et al. is directed to returning the taxonomy-related information in response to the request further comprises returning at least one node identifier corresponding to at least one node in the other taxonomy (page 7, paragraph 0068, lines 7-10).

As per claim 10 Carson et al. is directed to the relationship data indicates an equivalence relationship (figure 2a wherein healthcare(261) and banking(260) are on the same level in the taxonomy).

As per claim 11 Carson et al. is directed to returning the taxonomy-related information in response to the request further comprises returning at least one attribute value that indicates whether a node corresponding to that attribute value comprises a classification node (page 7, paragraph 0072, lines 3-6).

As per claim 12 Carson et al. is directed to returning the taxonomy-related information in response to the request further comprises returning at least one text string (page 5, paragraph 0048, second column, lines 9-10).

As per claim 13 Carson et al. is directed to the request includes at least one other set of identification data and relationship data, and wherein the response returns data corresponding to the request in the order in which the identification data and relationship data was received (page 7, paragraph, 0073, lines 1-4).

As per claim 14 Carson et al. is directed to the request comprises an XML message, and wherein returning the taxonomy-related information in response to the request further comprises formatting the response as an XML message (page 4, paragraph 0040, lines 5-7, wherein transportation could mean both request and response).

As per claim 15 Carson et al. is directed to the taxonomy-related information corresponds to a taxonomy maintained at a UDDI server (page 1, paragraph 0003, lines 6-8; page 7, paragraph 0068, line 1).

As per claim 16 Carson et al. is directed to a computer-readable medium having computer-executable instructions for performing the method of claim 1 (see rejection for claim 1).

As per claim 17 Carson et al. is directed to a in a computing environment, a method comprising:

constructing a request for taxonomy data, the request including identification data from which a taxonomy may be identified and at least one relationship qualifier (page 4, paragraph 0032, lines 4-5; page 7, paragraph 0072, lines 6-7; page 7, paragraph 0074, lines 2-4);

communicating the request to a server (page 1, paragraph 0003, lines 6-8);

receiving a response from the server including relationship information corresponding to the relationship qualifier (page 4, paragraph 0040, lines 7-8);

and presenting information about the taxonomy based on the relationship information in the response (page 4, paragraph 0040, line 12).

As per claim 18 Carson et al. is directed to the identification data comprises a unique identifier and the relationship qualifier indicates a root node relationship with the taxonomy, and wherein the response includes information about at least one root node in the taxonomy (page 7, paragraph 0070, lines 7-8).

As per claim 19 Carson et al. is directed to the identification data further includes node identification data from which a node within the taxonomy may be identified (page 7, paragraph 0070, lines 1-3; page 7, paragraph 0071, lines 1-3).

As per claim 20 Carson et al. is directed to the relationship qualifier indicates a parent node of a node identified by the node identification data, and wherein the response includes information about the parent node (page 7, paragraph 0074, line 2).

As per claim 21 Carson et al. is directed to the relationship qualifier indicates a child node of a node identified by the node identification data, and wherein the response includes information about at least one child node, if any exist (page 2, paragraph 0010, lines 6-14, wherein the child node is in a level below one mentioned in request).

As per claim 22 Carson et al. is directed to the relationship qualifier indicates an equivalent node of a node identified by the node identification data (page 2, paragraph 0010, lines 6-14, wherein the equivalent node is in on the same level as one mentioned in request).

As per claim 23 Carson et al. is directed to receiving the response from the server further includes receiving an attribute value that indicates whether a node in the taxonomy is intended as a classification node (figure 3 (30); page 7, paragraph 72).

As per claim 24 Carson et al. is directed to receiving the response from the server further includes receiving at least one text string that corresponds to a node in the taxonomy (page 5, paragraph 0048, second column, lines 9-10).

As per claim 25 Carson et al. is directed to constructing a request for taxonomy data comprises constructing an XML message (page 4, paragraph 0040, lines 5-7).

As per claim 26 Carson et al. is directed to communicating the request to a server comprises sending the XML message to a UDDI server (page 1, paragraph 0003, lines 6-8; page 4, paragraph 0040, lines 5-7; page 7, paragraph 0068, line 1).

As per claim 27 Carson et al. is directed to a computer-readable medium having computer-executable instructions for performing the method of claim 17 (see rejection for claim 17).

As per claim 28 Carson et al. is directed to in a computing environment, a system comprising:

a client, the client including an application program that presents taxonomy-related data (page 3, paragraph 0028, lines 3-4; page 3, paragraph 0027, lines 3-6)

and a server (page 1, paragraph 0003, lines 6-8) that maintains taxonomy data, the server coupled to receive taxonomy-related requests from the client seeking relationship information about nodes in a taxonomy, and in response to each request, to locate relationship information corresponding to a node in a specified taxonomy and to return a response to the client from which the client may present the taxonomy-related data (page 3, paragraph 0027, lines 5-7; page 7, paragraph 0068, lines 1-2).

As per claim 29 Carson et al. is directed to the relationship information corresponding to the node in the specified taxonomy comprises a root qualifier (page 2, paragraph 0010, lines 6-14).

As per claim 30 Carson et al. is directed to the relationship information corresponding to the node in the specified taxonomy comprises a parent qualifier (figure 2a, wherein retrieval(244) is parent of healthcare(261)).

As per claim 31 Carson et al. is directed to the relationship information corresponding to the node in the specified taxonomy comprises a child qualifier (figure 2a, wherein healthcare(261) is child of retrieval(244)).

As per claim 32 Carson et al. is directed to comprising a database in which the server maintains the taxonomy data (page 6, paragraph 0056, lines 8-9).

As per claim 33 Carson et al. is directed to the taxonomy-related requests from the client comprise XML messages (page 4, paragraph 0040, lines 5-7, wherein transportation could mean both request and response).

As per claim 34 Carson et al. is directed to the response to the client comprises an XML message (page 4, paragraph 0040, lines 5-7, wherein transportation could mean both request and response).

As per claim 35 Carson et al. is directed to the server comprises a UDDI server (page 1, paragraph 0003, lines 6-8; page 7, paragraph 0068, line 1).

As per claim 36 Carson et al. is directed to the client provides the request to the server by calling an application programming interface, the application programming interface formatting the request as a message for communicating with the server and returning the response to the client in response to the application programming interface call (page 5, paragraph 0049, lines 11-12).

As per claim 41 Carson et al. is directed to in a computing environment, a system comprising:

means for receiving a request that indicates identification data and relationship data corresponding to a taxonomy (page 4, paragraph 0032, lines 4-5; page 7, paragraph 0072, lines 6-7; page 7, paragraph 0074, lines 2-4);

and means for querying a database based on the identification data and relationship data to obtain taxonomy-related information about at least one node in the taxonomy (page 6, paragraph 0056, lines 8-9).

As per claim 42 Carson et al. is directed to means for returning the taxonomy-related information in response to the request (page 5, paragraph 0049, lines 11-12, wherein "the taxonomy" could mean "content").

As per claim 43 Carson et al. is directed to the means for querying the database comprises request handling means in a UDDI-server environment (page 1, paragraph 0003, lines 6-8; page 7, paragraph 0068, line 1).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Crisan et al. (US PUB 2003/0191769 A) teaches searching database from external calls.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tomasz Ponikiewski
April 14, 2006


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